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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,832	09/12/2001	Travis J. Parry	10013769-1	8146

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EXAMINER	
SHINGLES, KRISTIE D	
ART UNIT	**PAPER NUMBER**
2141	

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/954,832	PARRY ET AL.	
	Examiner	Art Unit	
	Kristie Shingles	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant has amended claims 1, 3, 8, 11, 18, 21 and 24.
Claims 1-32 are pending.

Response to Arguments

1. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. **Claims 1-5, 8, 11, 16-18, 21, 22, 24-27 and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Chong* (US 5,175,684) in view of *Hanawa* (US 6,519,630).

a. **Per claims 1 and 8** (differs by statutory subject matter), *Chong* teaches a method for facilitating generation of a hard copy, comprising:

- selecting a document file written in a first language (col.3 lines 59-65);
- selecting a translator configured to translate the document file into a second language (col.3 line 65-col.4 line 11); and

Yet *Chong* fails to explicitly teach selecting a translator file and packaging the document file and the translator together in a job package that can be received by a hard copy generation device. However, *Hanawa* teaches packaging and transmission of the conversion program with the e-mail message (col.10 line 54-col.11 line 55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Chong* and *Hanawa* for the purpose of packaging a translation file/driver/module with the data-to-be-translated in order to provide the receiving device a way to translate the transmitted message or file.

b. **Per claims 11 and 18** (differs by statutory subject matter), *Chong* teaches a method for generating a hard copy, comprising:

- receiving a job package comprising a document file representing a document, the document file written in a first language, and a translator configured to translate the document file into a second language (col.3 line 59-col.4 line 11);
- opening the job package (col.5 line 65-col.6 line 54 and col.7 line 1-col.8 line 65);
- using the translator to translate the document file into the second language (col.3 line 65-col.4 line 11 and col.8 lines 6-54); and
- generating a hard copy of the document (col.9 lines 21-44).

Yet *Chong* fails to explicitly teach using the translator file to translate the document file However, *Hanawa* teaches packaging and transmission of the conversion program with the e-mail message for converting the message into the proper format (col.10 line 54-col.11 line 55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Chong* and *Hanawa* for the purpose of packaging a

translation file/driver/module with the data-to-be-translated in order to provide the receiving device a way to translate the transmitted message or file.

c. **Per claims 21 and 24** (differs by statutory subject matter), *Chong* teaches a method for generating a hard copy, comprising:

- receiving an address that identifies the location of a job package that comprises a document file representative of a document, the document file written in a first language and a translator configured to translate the document file into a second language (col.3 line 59-col.4 line 8 and col.5 line 65-col.6 line 54);
- retrieving the job package (col.3 line 59-col.4 line 11);
- opening the package (col.5 line 65-col.6 line 54 and col.7 line 1-col.8 line 65);
- using the translator to translate the document file into the second language (col.3 line 65-col.4 line 63 and col.8 lines 6-54); and
- generating a hard copy of the document (col.9 lines 21-44).

Yet *Chong* fails to explicitly teach using the translator file to translate the document file However, *Hanawa* teaches packaging and transmission of the conversion program with the e-mail message for converting the message into the proper format (col.10 line 54-col.11 line 55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Chong* and *Hanawa* for the purpose of packaging a translation file/driver/module with the data-to-be-translated in order to provide the receiving device a way to translate the transmitted message or file.

d. **Per claim 2,** *Chong* and *Hanawa* teach the method of claim 1, *Chong* further teach wherein selecting a document file comprises selecting a document file identified by a user (col.7 line 3-18).

e. **Per claim 3,** *Chong* and *Hanawa* teach the method of claim 1, *Chong* further teach wherein the step of selecting a translator comprises selecting a translator identified by a user (col.4 lines 9-17 and col.6 lines 21-54).

f. **Per claim 4,** *Chong* and *Hanawa* teach the method of claim 1, *Chong* further teach further comprising the step of transmitting the job package to the hard copy generation device (col.9 lines 28-44).

g. **Per claim 5,** *Chong* and *Hanawa* teach the method of claim 1, *Chong* further teach further comprising the step of transmitting the job package to a recipient computing device (col.4 lines 9-63 and col.5 lines 11-54).

h. **Claim 27** is substantially similar to claim 5 and is therefore rejected under the same basis.

i. **Claim 29** is substantially similar to claim 4 and is therefore rejected under the same basis.

j. **Per claim 16,** *Chong* and *Hanawa* teach the method of claim 11, *Chong* further teach further comprising the step of registering with a remote computing device prior to generating the hard copy (col.9 lines 22-44).

k. **Per claim 17,** *Chong* and *Hanawa* teach the method of claim 16, *Chong* further teach wherein the step of generating a hard copy is enabled by the remote computing device (col.4 lines 9-63, col.5 lines 11-54 and col.9 lines 22-44).

l. **Per claim 22,** *Chong* and *Hanawa* teach the method of claim 21, *Chong* further teach wherein the step of retrieving the job package comprises retrieving the package from a remote location via a network (col.4 line 49-col.6 line 53, col.8 lines 19-43 and col.9 lines 22-44).

m. **Claim 25** is substantially similar to claim 22 and is therefore rejected under the same basis.

n. **Per claim 26,** *Chong* and *Hanawa* teach the method of claim 1, *Chong* further teach further comprising transmitting the job package over a network as an email attachment (col.9 lines 28-34; *Hanawa*: col.10 line 54-col.11 line 55).

4. **Claims 6, 7, 9, 10, 12-15, 19, 20, 23, 28, 30 and 32** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Chong* (US 5,175,684) and *Hanawa* (US 6,519,630) in view of *Adamske et al* (US 6,615,234).

a. **Per claim 6**, *Chong* and *Hanawa* teach the method of claim 1 as applied above, yet fails to explicitly teach method of claim 1, further comprising the step of encrypting the job package. However, *Adamske et al* disclose encryption of the translated document prior to delivery (col.3 line 64-col.4 line 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Chong* and *Hanawa* with *Adamske et al* for the purpose of provisioning security and the integrity of the document through the network by implementing encryption.

b. **Claims 9, 12 and 28** are substantially similar to claim 6 and are therefore rejected under the same basis.

c. **Per claim 32,** *Chong* and *Hanawa* teach the method of claim 21 as applied above, yet fails to explicitly teach the method of claim 21, wherein receiving an address comprises receiving a universal resource locator (URL) that identifies the location of the job package. However, *Adamske et al* disclose use of a URL for locating the document. *Adamske et al* teach encryptioin, and it is therefore intrinsic and obvious (in order to achieve effective communication) to provision a method of decryption along with encryption, in order for the document/data to be comprehensible to the appropriate recipient. Furthermore, *Adamske et al* restrict access to the encrypted documents by implementing security features with electronic signatures, pass phrases and user IDs that prohibit access of the document until authentication of the signatures, wherein the document will be decrypted for receipt and viewing once the authentication has been satisfied (col.6 lines 1-23 and col.8 line 24-col.9 line 32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Chong* and *Hanawa* with *Adamske et al* for the purpose of provisioning a decryption method along with an encryption method for making content accessible to the recipient and to furthermore utilize URLs as locators for documents, since URL provide access to electronic documents, data and media on the web/Internet.

d. **Claims 7, 10, 13-15, 19, 20, 23 and 30** contain limitations that are substantially similar to claim 32 and are therefore rejected under the same basis.

5. **Claim 31** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Chong* (US 5,175,684) and *Hanawa* (US 6,519,630) in view of *Adamske et al* (US 6,615,234) and further in view of *Nakamura et al* (US 6,064,836).

Per claim 31, *Chong* and *Hanawa* teach the method of claim 16 as applied above, as *Adamske et al* disclose use of a print spooler which keeps track of the number of hard copies have been generated and indicates when the hard copy generation has completed (col.7 lines 16-43 and col.7 line 57-col.8 line 10), yet all fail to explicitly teach the method of claim 16, wherein registering comprises registering with a remote computing device for the purpose of determining whether a total number of hard copies have already been generated and, if so, prohibiting generation of a further hard copy. However, *Nakamura et al* teach the determination of the number of generated copies and the prohibition of addition hard copies being made (col.1 line 40-col.2 lines 10, col.4 lines 25-51, col.6 lines 31-67, col.7 line 41-col.8 line 12, col.9 line 66-col.10 line 60, col.11 lines 48-56, col.12 lines 52-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Chong* and *Hanawa* with *Nakamura et al* with for the purpose of provisioning monitoring/tracking of the number of hard copies generated/printed in order to properly process the document/data in its entirety; because it allows for management of hard copy generation.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: *Wong et al* (US 2004/0015890), *Wecker et al* (US 6,311,058), *Tuchitoi et al* (US 2005/0141030), *Colaiuta* (US 2004/0205721), *Ozaki* (US 6,957,029), *Mori et al* (US 6,337,961).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles
Examiner
Art Unit 2141

kds

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER